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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,226	06/20/2003	Robert F. Burkholder	JK01507A	9184
28268 7590 01/22/2008 THE BLACK & DECKER CORPORATION 701 EAST JOPPA ROAD, TW199 TOWSON, MD 21286			EXAMINER FREAY, CHARLES GRANT	
			ART UNIT 3746	PAPER NUMBER
			MAIL DATE 01/22/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/601,226

Applicant(s)

BURKHOLDER ET AL.

Examiner

Charles G. Freay

Art Unit

3746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 51, 52, 56-66 and 68-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51, 52, 56-65 and 75 is/are allowed.
- 6) ☒ Claim(s) 68-72 is/are rejected.
- 7) ☒ Claim(s) 66, 72 and 73 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This office action is in response to the amendment of November 5, 2007. In making the below rejections the examiner has considered and addressed each of the applicant's arguments.

### ***Claim Objections***

Claim 66 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim depends from cancelled claim 5 which has been incorporated into claim 51.

Claim 74 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim depends from cancelled claim 54 which has been incorporated into claim 51.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 68-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ushiota et al (USPN 5,030,067) in view of Beckman et al (USPN 6,991,436).

Ushiota et al disclose a hand portable air compressor (Fig. 8) having an air tank (46), a compressor (44), a motor (42), a shroud (82) substantially enclosing the compressor tank and motor, and a pressure regulator (72). The shroud is not set forth as made of plastic or that the shroud supports the tank, compressor and motor.

Beckmann et al disclose an air compressor system having a clam shell shroud which is made of plastic (col. 5 line 46) that supports the elements therein (see col. 2 lines 45-48

and Figs. 4 and 5). Beckman et al clearly shows integral internal support members (Fig. 4 such as at 102, 92). At the time of the invention one of ordinary skill in the art would have found it obvious to construct the generically disclosed shroud of Ushiota et al as more clearly shown in Beckman et al in order to provide lightness, durability and also to support the members within the shroud so that the elements do not "rattle around" and translate relative to the shroud when the shroud is lifted or set down. Such support would keep the components in a fixed relative position with respect to the shroud. With regards to claims 69-71 the examiner notes that the limitations of the "base portion" and the "front portion" and "rear portion" and generally relative terms and are broadly set forth. For example, in figure 8 the base portion could be considered the flat side through which the feet extend and when placed on a flat surface the handle would be above the base portion. Furthermore the vertical plane of claim 71 could be a line extending up and down in Fig. 8 which passes through the handle and the front portion would be everything to the right of the line and the rear portion would be everything to the left of the line.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 68-72 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 8-10 and 13-15 of copending Application No. 10/805836 in view of Ushiota et al. The claims of the ('836) application set forth a hand portable air compressor assembly having a tank and a shroud having ribbing which is plastic. The ribbing supporting the tank member therein. ('836) does not specifically set forth an air compressor or a motor which are within and supported by the shroud or that the shroud has a handle. Ushiota et al discloses a hand portable air compressor having a motor (42), an air compressor (44) and a tank (46), as set forth in detail above, within a shroud. At the time of the invention it would have been obvious to one of ordinary skill in the art to include a motor and an air compressor within the shroud of ('836), as taught by Ushiota et al, in order to create a hand portable air compressor which is an integral unit and has the motor and compressor located within the protective and supporting shroud. It also would have been obvious to provide the ('836) shroud with a handle as disclosed by Ushiota et al to make the hand portability easier.

This is a provisional obviousness-type double patenting rejection.



***Allowable Subject Matter***

Claims 51, 52, 56--65 and 75 are allowed.

Claim 73 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed November 5, 2007 have been fully considered but they are not persuasive. The applicant argues, with respect to new claims 68-74, that Ushiota et al discloses that the tank, compressor and motor are joined together by a joining part (48) and supported by legs (64). The examiner does not find this argument persuasive. It is noted that the claim only sets forth that "the motor, air tank and air compressor are supported within the shroud". The applicant's arguments relate to the support of the entire unit with respect to floor or other surface which it is set on. As set forth in the rejections above the members would still have to be supported with respect to the shroud and this feature is obvious in view of the prior art as noted above.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fussel and Whitley II et al disclose plastic housings members supporting internal pump and compressor elements.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles G. Freay whose telephone number is 571-272-4827. The examiner can normally be reached on Monday through Friday 8:30 A.M. to 5:30 P.M..

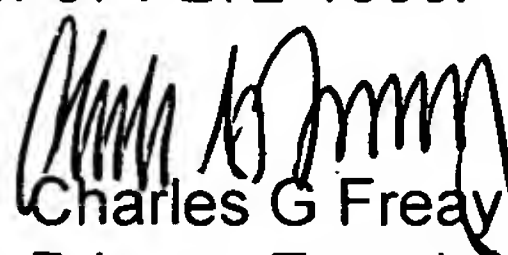
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on 571-272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Charles G Freay  
Primary Examiner  
Art Unit 3746

CGF  
January 6, 2007